



*DAE*  
*ZPW*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Confirmation No.: 7849

Bruce Karsh et al.

Group Art Unit No.: 3714

Serial No.: 10/671,026

Examiner: Frisby, Kesha

Filed: September 24, 2003

For: VISIBLY DISTINGUISHING PORTIONS  
OF COMPOUND WORDS

Mail Stop Petitions  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF ABANDONMENT**  
**PURSUANT 37 CFR 1.181**

Sir:

On September 24, 2003, the above identified application was filed. At the time of filing, customer number 29989 was indicated on the transmittal (attached). Applicant received the Official Filing Receipt (attached) from the United States Patent and Trademark Office dated December 19, 2003 which included our customer number 29986.

On December 17, 2004 Applicant fax filed a Request for Customer Number Data Change, PTO/SB/12A (attached including fax cover sheet; fax confirmation sheet, dated December 17, 2004 and December 22, 2004; and USPTO Auto-Reply Facsimile Transmission dated December 17, 2004), changing Applicant's address to 2055 Gateway Place, Suite 550; San Jose CA 95110.

However, Office Action dated May 9, 2006 was sent to Applicant's previous

address and was returned to the United States Patent and Trademark Office after

Applicant had properly submitted address change forms. Therefore, Applicant respectfully requests that the Office Action be re-issued and that the period for responding thereto be reset. Further, if the application has in any way been held to be abandoned, Applicant respectfully requests that this holding be withdrawn.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER  
LLP

Dated: 1/8/2007

Christian A. Nicholes

Christian A. Nicholes  
Reg. No. 50,266

2055 Gateway Place, Suite 550  
San Jose, CA 95110  
Telephone No.: (408) 414-1080  
Facsimile No.: (408) 414-1076

**CERTIFICATE OF MAILING**

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on

1/8/2007

by

Annette Valdivia  
Annette Valdivia



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	<b>10/671,026</b>
	Filing Date	<b>9/24/2003</b>
	First Named Inventor	<b>Bruce Karsh</b>
	Art Unit	<b>3714</b>
	Examiner Name	<b>Frisby, Kesha</b>
Total Number of Pages in This Submission	Attorney Docket Number	<b>50269-0562</b>

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Petition Fee Transmittal  <input checked="" type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers Petition for Withdrawal of Abandonment Pursuant to 37 CFR 1.181 <input checked="" type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation  <input type="checkbox"/> Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below): Copy of: Application transmittal, Official Filing receipt, request for customer number data change, fax cover sheet, fax confirmation sheets, USPTO auto reply transmission; Check \$400.00 and Return receipt postcard
<b>Remarks</b> The Director is hereby authorized to charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 to Deposit Account Number 50-1302 Deposit Account Name: Hickman Palermo Truong & Becker LLP		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Hickman Palermo Truong & Becker LLP		
Signature			
Printed name	Christian A. Nicholes		
Date	1/8/2007	Reg. No.	50,266

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Annette Valdivia	Date	1/8/07

SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



PTO/SB/17p (11-05)

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**PETITION FEE**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/671,026
Filing Date	September 24, 2003
First Named Inventor	Bruce Karsh
Art Unit	3714
Examiner Name	Frisby, Kesha
Attorney Docket Number	50269-0562

**Enclosed is a petition filed under 37 CFR 1.181 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$400.00 is enclosed.**This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. *For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.***Payment of Fees** (small entity amounts are NOT available for the petition fees)☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 50-1302 :☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☒ Check in the amount of \$400.00 is enclosed.☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

  
SignatureChristian A. Nicholes  
Typed or printed name1/8/2007  
Date50,266  
Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## UTILITY PATENT APPLICATION TRANSMITTAL

Attorney Docket No.  
50269-0562

(New Nonprovisional Applications Under 37 CFR § 1.53(b))

## TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is the patent application of ( ) application identifier or (X) first named inventor,  
DUCE KARSH, ET AL., entitled VISIBLY DISTINGUISHING PORTIONS OF COMPOUND WORDS, for a(n):

(X) Original Patent Application.

( ) Continuing Application (prior application not abandoned):

( ) Continuation ( ) Divisional ( ) Continuation-in-part (CIP)  
of prior application No: Filed on:

( ) A statement claiming priority under 35 USC § 120 has been added to the specification.

## Enclosed are:

(X) Specification 30 Total Pages; (X) Drawing(s) 8 Total Sheets; (X) Cover Sheet 1 Page

(X) Oath or Declaration: 2 Pages

( ) A Newly Executed Combined Declaration and Power of Attorney:

( ) Signed. ( ) Unsigned. ( ) Partially Signed.

( ) A Copy from a Prior Application for Continuation/Divisional (37 CFR § 1.63(d)).

( ) Incorporation by Reference. The entire disclosure of the prior application, from which a copy of the  
oath or declaration is supplied, is considered as being part of the disclosure of the accompanying  
application and is hereby incorporated herein by reference in its entirety for all purposes.

( ) Signed Statement Deleting Inventor(s) Named in the Prior Application. (37 CFR § 163(d)(2)).

( ) Power of Attorney.

(X) Return Receipt Postcard.

( ) Associate Power of Attorney.

(X) A Check in the amount of \$ 790.00 for the Filing Fee.

( ) Preliminary Amendment.

( ) Information Disclosure Statement and Form PTO-1449.

(X) Request and Certification Under 35 U.S.C. 122(b)(2)(B)(i)

(X) A Duplicate Copy of this Form for Processing Fee Against Deposit Account.

( ) A Certified Copy of Priority Documents (if foreign priority is claimed).

( ) Applicant(s) is entitled to small entity status. See 37 CFR 1.27.

( ) Statement(s) of Status as a Small Entity Filed in Prior Application, Status Still Proper and Desired.

(X) Recordation of Assignment Cover Sheet and executed Assignment.

( ) Other:

CLAIMS AS FILED				
FOR	NO. FILED	NO. EXTRA	RATE	FEE
Total Claims	14	0	\$18.00	\$ 0.00
Independent Claims	2	0	\$84.00	\$ 0.00
Multiple Dependent Claims (if applicable)				\$0.00
Assignment Recording Fee				\$40.00
Basic Filing Fee				\$750.00
Total Filing Fee				\$ 790.00

Charge \$ to Deposit Account 50-1302 pursuant to 37 CFR § 1.25. Throughout the pendency of this  
application, please charge any additional fees, including any required extension of time fees, and credit all overpayments  
to deposit account 50-1302. A duplicate of this sheet is enclosed.

Respectfully submitted,

By:

Christian A. Nicholes, Attorney of Record, Reg. No. 50,266

Date: September 24, 2003

Correspondence Address:



29989

PATENT TRADEMARK OFFICE

I hereby certify that this is being deposited with the U.S. Postal  
Service "Express Mail Post Office to Addressee" service under  
37 CFR § 1.10 on the date indicated below and is addressed to:

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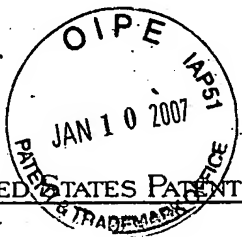
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/671,026	09/24/2003	3713	750	50269-0562	8	14	2

29989

HICKMAN PALERMO TRUONG & BECKER, LLP  
 1600 WILLOW STREET  
 SAN JOSE, CA 95125

DEC 22 2003

CONFIRMATION NO. 7849

FILING RECEIPT



\*OC000000011537606\*

Date Mailed: 12/19/2003

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Bruce Karsh, Half Moon Bay, CA;  
 Martin Eckert, San Jose, CA;  
 Chung Kei Wong, Fremont, CA;

Domestic Priority data as claimed by applicant

Foreign Applications

If Required, Foreign Filing License Granted: 12/19/2003

Projected Publication Date: Request for Non-Publication Acknowledged

Non-Publication Request: Yes

Early Publication Request: No

Title

Visibly distinguishing portions of compound words

Preliminary Class

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DATES:

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**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

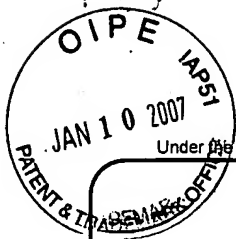
The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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To the Commissioner for Patents:

29989

Please record the following data changes to **Customer Number**:☒ Please change Address to:

<b>Firm or Individual Name</b>	Hickman Palermo Truong & Becker, LLP				
<b>Address</b>	2055 Gateway Place, Suite 550				
<b>City</b>	San Jose	<b>State</b>	California	<b>Zip</b>	95110
<b>Country</b>	United States of America				
<b>Telephone</b>	(408) 414-1080	<b>Fax</b>	(408) 414-1076		

☐ Please delete the following practitioner registration number(s) from the Customer Number indicated above:


☐ Please add the following practitioner registration number(s) from the Customer Number above:


☐ Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto (PTO/SB/124B or equivalent)**Request Submitted by:** (must be a person, e.g. registered practitioner, associated with the customer number shown above)

<b>Firm Name (if applicable)</b>	Hickman Palermo Truong & Becker, LLP		
<b>Signature</b>			
<b>Name of Person Submitting request</b>	Edward A. Becker	<b>Registration No.</b>	37,777
<b>Telephone Number</b>	(408) 414-1204	<b>Date</b>	December 17, 2004

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop EBC, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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HICKMAN PALERMO TRUONG & BECKER LLP  
1600 WILLOW STREET  
SAN JOSE, CALIFORNIA 95125-5106  
TEL: (408) 414-1080  
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FACSIMILE TRANSMITTAL SHEET

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TO:	Electronic Business Center	FROM:	Edward A. Becker
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☒ URGENT    ☐ FOR REVIEW    ☐ PLEASE COMMENT    ☐ PLEASE REPLY    ☐ PLEASE RECYCLE

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NOTES/COMMENTS:

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Thank you for your assistance with this matter.

Edward A. Becker

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☒ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ PLEASE RECYCLE

### NOTE/COMMENTS:

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Edward A. Becker

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